

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Initially Applicants note that the references JP 5-325500, JP 11-242873, JP 2003-68060, and WO 01/86652, cited in the Information Disclosure Statement (IDS) filed July 22, 2005, continue to not be initialed as being considered by the Examiner. It is respectfully requested that these references be considered, as discussed during a telephone conversation with Examiner Vu on April 28, 2009.

Claims 1-28 are currently pending. Claims 1, 5-7, 9, 12, and 15-18 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.¹

In the outstanding Office Action, Claim 1 was objected to as containing an informality; Claims 1-3, 5-10, 12, 13, and 15-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0010415 to Seo et al. (hereinafter “the ‘415 application”) in view of U.S. Patent No. 6,469,239 to Fukuda (hereinafter “the ‘239 patent”); and Claims 4, 11, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘415 application in view of the ‘239 patent and U.S. Patent Application Publication No. 2004/0117547 to Ogihara et al. (hereinafter “the ‘547 application”).

Further, it is noted that the Office Action, at page 2, states

On page 3 lines 5-6 of the instant specification, “*the recording medium*” is referenced as a disc-shaped recording medium corresponding to a hardware device. Thus, independent claims 6, 7, 9, 12 and 15-18 recited “the recording medium” are properly claimed in accordance with 35 U.S.C. §112, sixth paragraph.

¹ See, e.g., page 16, lines 3-15 and page 18, lines 6-12 of the originally filed specification.

Applicants respectfully submit to not understanding the above quoted statement, and request clarification as to the application of 35 U.S.C. § 112, sixth paragraph, with respect to the claimed “recording medium.” For example, it is noted that MPEP § 2181 provides that “a claim element that does not include the phrase ‘means for’ or ‘step for’ will not be considered to invoke 35 U.S.C. 112, sixth paragraph.”

CLAIM OBJECTION

The Office Action indicates that Claim 1 is objected “for improper construction of computer readable storage medium preamble,” and indicates that Claim 1 should be written as “A computer program embodied on a computer readable storage medium having executable instructions when executed by a processor perform:”.

However, it is noted that Claim 1 is directed to a computer-readable storage medium comprising a contents area and a database area, supplementary data included in a contents file or the supplementary data included in a database file being accessed by a reproducing apparatus based on a memory capacity of the reproducing apparatus. Claim 1 is not directed to a method performed by a processor when executing executable instructions on a computer-readable storage medium. Accordingly, it is respectfully requested that the objection to Claim 1 be withdrawn.

REJECTION UNDER 35 U.S.C. § 103

Amended Claim 1 is directed to a computer-readable storage medium, comprising:

a contents area configured to record a contents file, the contents file including contents data and supplementary data corresponding to said contents data; and

a database area, separate from the contents area, configured to record a database file, the database file including said supplementary data corresponding to said contents data included in the contents file, wherein

*said supplementary data included in the contents file or
said supplementary data included in the database file is
accessed by a reproducing apparatus based on a memory
capacity of the reproducing apparatus,*

*said supplementary data included in the contents file is
accessed when the reproducing apparatus has a small memory
capacity, and*

*said supplementary data included in the database file is
accessed when the reproducing apparatus has a sufficient
memory capacity.*

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action acknowledges, and it is respectfully submitted, that the '415 application fails to disclose

"wherein a reproducing apparatus having a small memory capacity accesses said supplementary data included in the contents file."² Rather, the Office Action cites the '239 patent for such a teaching. Thus, it is respectfully submitted that the '415 application fails to disclose the supplementary data defined in Claim 1.

The '239 patent is directed to a data storage apparatus and data storage method with quality degrading features. In particular, the Office Action cites steps S41-S45 of the '239 move process for teaching "wherein a reproducing apparatus having a small memory capacity accesses said supplementary data included in the contents file," asserting that the '239 file size of the compression music data corresponds to the supplementary data included in the contents file.³

However, it is respectfully submitted that the '239 patent fails to disclose that supplementary data included in the database file is accessed by a reproducing apparatus based on a memory capacity of the reproducing apparatus, said supplementary data included in the contents file is accessed when the reproducing apparatus has a small memory capacity, and said supplementary data included in the database file is accessed when the reproducing apparatus has a sufficient memory capacity. Rather, the '239 patent simply discusses when it

² See Office Action dated January 28, 2009, page 6.

³ Id. at pages 6 and 7.

is determined in step S41 that there is a moving request of the compression music data, **a file size of compression music data** whose move has been designated, namely, a data amount **is examined by, for example, the CPU 8 on the server 50 side in step S42**. In next step S43, the '239 patent discusses that a vacant capacity of the HDD 106, namely a recordable memory capacity is checked by, for example, the CPU 105 of the portable recording and reproducing apparatus 70. The vacant capacity of the HDD 106 and the file size of the compression music data whose move has been designated and which was examined in step S42 are compared by, for instance, the CPU 8 of the server 50. On the basis of a comparison result in step S42, the CPU 8 discriminates whether the compression music data in which the move has been designated can be recorded to the HDD 106. The '239 patent discusses that when it is determined in step S43 that the vacant capacity in the HDD 106 of the portable recording and reproducing apparatus 70 is insufficient, the compression music data which has already been recorded to the HDD 106 is deleted automatically or on the basis of a procedure or method by the CPU 105 of the apparatus 70 so that the compression music data whose move has been designated can be recorded to the HDD 106.⁴

The '239 patent does not disclose file size of compression music data *included in a contents file is accessed* by a portable recording and reproducing apparatus 70 *having a small memory capacity*, and file size of compression music data *included in a database file is accessed* by a portable recording and reproducing apparatus 70 *having a sufficient memory capacity*.

Thus, no matter how the teachings of the '415 application and the '239 patent are combined, the combination does not teach or suggest the supplementary data defined in Claim 1. Accordingly, it is respectfully submitted that Claim 1 (and all associated dependent

⁴ See '239 patent, column 17, line 66 to column 18, line 27.

claims) patentably defines over any proper combination of the '415 application and the '239 patent.

Amended Claim 5 recites, in part,

said supplementary data included in the contents file or
said supplementary data included in the database file is
accessed by a reproducing apparatus based on a memory
capacity of the reproducing apparatus,

said supplementary data included in the contents file is
accessed when the reproducing apparatus has a small memory
capacity, and

said supplementary data included in the database file is
accessed when the reproducing apparatus has a sufficient
memory capacity.

Amended Claim 6 recites, in part,

said supplementary data included in the contents file or
said supplementary data included in the database file is
accessed by a reproducing apparatus based on a memory
capacity of the reproducing apparatus,

said supplementary data included in the contents file is
accessed when the reproducing apparatus has a small memory
capacity, and

said supplementary data included in the database file is
accessed when the reproducing apparatus has a sufficient
memory capacity.

Amended Claim 7 recites, in part,

said supplementary data included in the contents file or
said supplementary data included in the database file is
accessed by the reproducing apparatus based on a memory
capacity of the reproducing apparatus,

said supplementary data included in the contents file is
accessed when the reproducing apparatus has a small memory
capacity, and

said supplementary data included in the database file is
accessed when the reproducing apparatus has a sufficient
memory capacity.

Amended Claim 9 recites, in part,

said supplementary data included in the contents file or
said supplementary data included in the database file is
accessed by the reproducing apparatus based on a memory
capacity of the reproducing apparatus,

said supplementary data included in the contents file is
accessed when the reproducing apparatus has a small memory
capacity, and

said supplementary data included in the database file is
accessed when the reproducing apparatus has a sufficient
memory capacity.

Amended Claim 12 recites, in part,

the read out means reads out said supplementary data
included in the contents file or said supplementary file included
in the database area based on a memory capacity of the
reproducing apparatus,

the read out means reads out said supplementary data
included in the contents file when the reproducing apparatus
has a small memory capacity, and

the read out means reads out said supplementary data
included in the database file when the reproducing apparatus
has a sufficient memory capacity.

As noted above, the '415 application and the '239 patent, alone or in proper
combination, fail to disclose the supplementary data recited in Claim 1. Thus, the '415
application and the '239 patent fail to disclose the recording method and recording apparatus
recited in Claims 5 and 6, respectively. Further, the '415 application and the '239 patent fail
to disclose the reproducing apparatus recited in Claims 7, 9, and 12, respectively.
Accordingly, it is respectfully submitted that Claims 5-7, 9, and 12 (and all associated
dependent claims) patentably define over any proper combination of the '415 application and
the '239 patent.

Amended Claims 15-18 recite limitations analogous to the limitations recited in
Claims 6, 7, 9, and 12, respectively, but in non-means-plus-function format. Accordingly, for
reasons analogous to the reasons stated above for the patentability of Claims 6, 7, 9, and 12, it

is respectfully submitted that Claims 15-18 patentably define over any proper combination of the '415 application and the '239 patent.

Regarding the rejections of Claims 4, 11, and 14 under 35 U.S.C. § 103(a), it is respectfully submitted that the '547 application fails to remedy the deficiencies of the '415 application and the '239 patent, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 4, 11, and 14 patentably define over any proper combination of the '415 application, the '239 patent, and the '547 application.

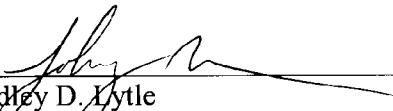
CONCLUSION

Thus, it is respectfully submitted that independent Claims 1, 5-7, 9, 12, and 15-18 (and all associated dependent claims) patentably define over any proper combination of the '415 application, the '239 patent, and the '547 application.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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